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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,951	12/08/2003	Kouichi Sugiyama	00862.023356.	9003
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EXAMINER				
THOMAS, ASHISH				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/728,951

Applicant(s)

SUGIYAMA, KOUICHI

Examiner

ASHISH K. THOMAS

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 8, 10-13, 15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 10-13, 15, and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/24/2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to the independent claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 7, the claim language consists of a first generation unit, a second generation unit, and a third generation unit. However, the Specification does

not explicitly describe these units. In view of this, it is difficult to ascertain which of the parts described in the detailed description correlate to the first, second, and third generation units.

Regarding claim 11, the claim language describes a first generation unit. The above described difficulties are applicable to this claim as well.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 7, 8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer(U.S. 6,373,588) in view of Noda(U.S. 6,267,517) and further in view of Iwasaki(U.S. 6,249,741).

Regarding claim 7, Fischer teaches an information processing apparatus(**host 45 in figure 1**) for sending a print job to a printing apparatus(**printer 10 in figure 1**), said information processing apparatus comprising: a first generation unit adapted to generate a combined print job by combining a first print job and a second print job, the first print job including first page data and first banner print data for printing first banner information. **(Figure 5, step 325 teaches a multiple copy operation that combines all the copies. This reads on the combining a first and second print job. The first generation unit is inherently taught in this reference. Furthermore, figure 5, step**

330 teaches that each print job consists of the banner data as well. This reads on the first banner print data stated in the claim language.)

Fischer also teaches a sending unit adapted to send the first page data and the second page data to the printing apparatus, as the combined print job. **(Column 10, lines 13-25 teaches that the combined copy job is outputted. This, in turn, inherently teaches the sending unit stated in the claim language. Note that figure 1 illustrates this concept as well.)**

But Fischer is silent on the second print job including second page data different from the first page data and second banner print data for printing second banner information different from the first banner information.

Noda, on the other hand, teaches a second print job including second page data different from the first page data and second banner print data for printing second banner information different from the first banner information. **(Column 5, lines 10-20 teaches that a banner data is different for each user. This reads on the second banner print data being different from the first banner information.)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Fischer with Noda to put forth an information processing apparatus wherein a plurality of jobs are combined, each of the jobs having a different banner data.

The motivation behind the modification is to combine not just jobs with similar banner data but also combine jobs with different banner data. This way, if the user

desires different jobs to be grouped together and printed at one location, it can be realized.

But the combination of Fischer and Noda fails to teach a second generation unit adapted to generate new data for printing new information, the new print is for printing new information different from the first information and the second information. This combination also fails to teach sending the new print data so that the new print information, without printing the first information and the second information is printed.

Iwasaki, on the other hand, teaches, a second generation unit adapted to generate new data for printing new information, the new print is for printing new information different from the first information and the second information. **(Column 7, lines 15-20 teaches N itineraries. The N itineraries read on the first and second information. This reference also teaches that the group schedule data is produced from combining the N itineraries. The group schedule data reads on the new print information. Note that the ability to produce the new group schedule data inherently teaches a generation unit that can generate it.)** Iwasaki also teaches sending the new print data so that the new print information, without printing the first information and the second information is printed. **(Column 7, lines 40-55 teaches the creation of the new data. Also note that printer 42 in figure 1 can print the newly combined data.)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Fischer and Noda with Iwasaki to fully put forth the apparatus claimed in claim 7 wherein a second generation unit adapted to generate

new banner print data for printing new banner information wherein the new banner print is for printing new banner information different from the first banner information and the second banner information for the combined job. The combination also teaches sending the new banner print data so that the new banner print information, without printing the first banner information and the second banner information, is printed on a sheet.

The motivation behind this combination is to create revised data since the old banner data is no longer applicable since that only applies to the jobs before the combination.

Regarding claim 1, it is rejected in the same manner as claim 7 since a corresponding method claimed is disclosed.

Regarding claims 2 and 11, the combination of Fischer, Noda, and Iwasaki teaches the combined print job data is generated by disabling data execution of banner printing included in the first and second print jobs. **(Column 10, lines 13-25 of Fischer teaches that banner sheet is not outputted for each copy, rather only for the combined print job. This is an example of disabling banner data printing for each of the plurality of print jobs.)**

Regarding claims 3 and 12, Fischer teaches setting layout information on a number of pages laid out on a print sheet for the single print job. **(Column 2, lines 43-48 teaches page settings with respect to the document portion of the print job.)** Fischer also teaches that the layout information is applied to the combination print data without being applied to the banner print data, and the single print job is outputted to the

printing apparatus in the output step. **(Column 2, lines 48-51 teaches that the layout information of the banner page is independent of the rest of the print data. Figure 4 teaches that the printer 10 outputs the combined job data.)**

Regarding claim 8, Fischer further teaches a computer-readable storage medium storing a computer-executable program for causing a computer to implement the printing control method. **(Column 3, lines 45-55)**

Regarding claims 10 and 13, Fischer teaches that banner print data is data indicating designation of banner printing or banner pages. **(Column 1, lines 15-25 details some examples of banner print data that is printed.)**

5. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer(U.S. 6,373,588) in view of Noda(U.S. 6,267,517), Iwasaki(U.S. 6,249,741), and Sakai(U.S. 5,887,223).

Regarding claim 15 and 17, the combination of Fischer, Noda, and Iwasaki teaches the subject matter claimed in the respective base claims. Fischer further teaches that user data such as the name of the user is included in the banner sheet**(column 1, lines 15-25).**

But this combination fails to teach that a print time is also included in the banner sheet.

Sakai, on the other hand, teaches that the print time is included in a banner sheet. **(column 8, lines 35-40)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Noda, Fischer, and Iwasaki with Sakai to fully put forth the subject matter claimed in claims 15 and 17.

The motivation behind this modification is to provide a banner sheet with as much as information as possible so that the user can easily distinguish the printed jobs.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHISH K. THOMAS whose telephone number is (571)272-0631. The examiner can normally be reached on Mon-Fri from 0700-1530 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Ashish K Thomas/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625